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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,913	06/23/2003	Patricia Gordon	GP087-04.CN1	8083
21365 7590 12/13/2007 GEN PROBE INCORPORATED 10210 GENETIC CENTER DRIVE Mail Stop #1 / Patent Dept. SAN DIEGO, CA 92121			EXAMINER KIM, YOUNG J	
			ART UNIT 1637	PAPER NUMBER
			NOTIFICATION DATE 12/13/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdept@gen-probe.com
kelleec@gen-probe.com
belindao@gen-probe.com

Office Action Summary

Application No.

10/601,913

Applicant(s)

GORDON ET AL.

Examiner

Young J. Kim

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8,11,13-15 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8 and 20-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on September 7, 2007 has been entered.

Preliminary Remark

The examiner of record has been changed.

All future correspondence should be directed to Young J. Kim, in Group Art Unit 1637.

Claims 3, 6, 7, 9, 10, 12, and 16-19 are canceled.

Election/Restrictions

Claims 11 and 13-15 remain withdrawn as being drawn to non-elected invention, non-election occurring without traverse, in the response received on May 4, 2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4, 5, 8, and 20-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 recites the phrase, "a first hybridization assay probe...wherein the base sequence of said first probe is up to 100 bases in length and consists of a first target binding region having no more than about 10% base difference with a base sequence selected from the group consisting of SEQ ID NO: 5, SEQ ID NO: 6..."

It is unclear whether the phrase, "a base sequence" is referring to the entire base sequence of SEQ ID Numbers or any dinucleotide sequence found in the SEQ ID Numbers.

For the purpose of prosecution, the former interpretation is assumed.

Claims 4, 5, 8, and 20-30 are indefinite analogously.

Claim 2 is indefinite by way of its dependency on claim 1.

Claim Rejections - 35 USC § 102

The rejection of claims 1, 2, 5, 8 and 22 under 35 U.S.C. 102(e) as being anticipated by Gudibande et al (U.S. Patent 5,597,910), made in the Office Action mailed on February 5, 2007 is withdrawn in view of the Amendment received on September 7, 2007.

Applicants' amendment to remove the term, "about" in the phrase, "about 10%" and in the phrase, "about 20%" over comes the rejection of record.

The rejection of claims 1 and 2 under 35 U.S.C. 102(e) as being anticipated by Bouma et al (U.S. Patent 5,484,699), made in the Office Action mailed on February 5, 2007 is withdrawn in view of the Amendment received on September 7, 2007.

Applicants' amendment to remove the term, "about" in the phrase, "about 10%" and in the phrase, "about 20%" over comes the rejection of record.

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Rejections, New Grounds

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Kacian et al. (U.S. Patent No. 5,871,975, issued February 16, 1999, filed March 25, 1997, priority March 10, 1994).

Kacian et al. disclose a probe sequence consisting of SEQ ID Number 7 which is the exact sequence of SEQ ID Number 5.

Specifically, Kacian et al. disclose the following sequence:

5'-GAACAGCAATACAACAAACCGTTGTGTG-3'

This sequence is an exact match to SEQ ID Number 5 of the instant application.

In addition, Kacian et al. explicitly disclose that this probe was hybridized with its target nucleic acid (column 11, line 41-43).

Therefore, Kacian et al. anticipate the invention as claimed.

Claim Rejections - 35 USC § 103

The rejection of claims 1, 2, 4, 5, 8 and 20-30 under 35 U.S.C. 103(a) as being unpatentable over Brown et al (WO 94/26934) in view of Gudibande (U.S. Patent 5,597,910) and further in view of Hogan et al (U.S. Patent 5,030,557) and further in view of Dopazo et al (J. Virol. Meth. (1993)

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41:157-166), made in the Office Action mailed on February 5, 2007 is withdrawn in view of the Amendment received on September 7, 2007.

Applicants' amendment to remove the term, "about" in the phrase, "about 10%" and in the phrase, "about 20%" over comes the rejection of record.

Conclusion

No claims are allowed.

Inquiries

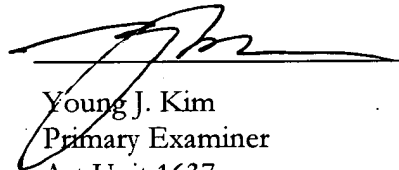
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (571) 272-0785. The Examiner is on flex-time schedule and can best be reached from 8:30 a.m. to 4:30 p.m (M-W and F). The Examiner can also be reached via e-mail to Young.Kim@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Gary Benzion, can be reached at (571) 272-0782.

Papers related to this application may be submitted to Art Unit 1637 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. All official documents must be sent to the Official Tech Center Fax number: (571) 273-8300. For Unofficial documents, faxes can be sent directly to the Examiner at (571) 273-0785. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Young J. Kim
Primary Examiner
Art Unit 1637
12/4/2007

**YOUNG J. KIM
PRIMARY EXAMINER**

YJK